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In re PATENT Application of:

David GREENBLATT

Appl. S.N.: 09/575,707

Filing Date: July 20, 2000

Title: **TELECOMMUNICATIONS CONTROL
SYSTEM USING DATA INTERCHANGE**

Confirmation No.: 5304

Attorney Docket: 2655-0077

Group Art Unit: 2141

Examiner: NGUYEN, Quang N.

Date: October 24, 2005

REPLY BRIEFHon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer dated August 25, 2005, remarks are submitted starting on page 4. A separate request for Oral Hearing is being submitted simultaneously.

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STATUS OF THE CLAIMS

The status of the claims is unchanged: Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23 and 28-54 stand finally rejected and are herein appealed. Claims 2, 4, 6, 8-10, 12, 14-15, 17-19, 21, 24-27 are cancelled.

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GROUND OF REJECTION

The grounds for rejection remain unchanged from the Appeal Brief as no new grounds were raised by the Examiner's Answer. Thus, the grounds for rejection are:

The first issue for review is whether one or more of Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, 31-33, 40-45, and 49-54 are unpatentable over Voit (U.S. Pat. No. 6,104,711, hereafter "the '711 patent") in view of Haitsuka et al. (U.S. Pat. No. 6,505,201, hereafter "the '201 patent") and further in view of DeGolia, Jr. et al. (U.S. Pat. No. 6,411,615, hereafter "the '615 patent") under 35 U.S.C. § 103(a). The second issue for review is whether any of Claims 28-30 and 46-48 are unpatentable over the '711 patent in combination with the '201 patent and the '615 patent and further in combination with Venkatachary et al. (U.S. Pat. No. 6,212,184, hereafter "the '184 patent")¹ under 35 U.S.C. § 103(a). The third issue for review is whether any of Claims 34-39 are unpatentable over the '711 patent in view of the '201 patent and the '615 patent and further in view of Federov et al. (U.S. Pat. No. 6,047,060, hereafter "the '060 patent") under 35 U.S.C. § 103(a).

¹ Appellant notes that the Office Actions sometimes refer to Venkatachary et al. as U.S. Pat. No. 6,411,615 (see, e.g., Advisory Action of February 18, 2005 at page 6).

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REMARKS

It is respectfully submitted that the outstanding final rejection be reversed for the reasons set forth in the appeal brief filed June 13, 2005, as well as for the reasons set forth herein.

Arguments relating to claims 1, 3, 5, 7, 11, 13, 16, 20 22, 23, 31-33, 40-45 and 49-54

In applicant's appeal brief, it was argued that there was no motivation to combine the references, and, in fact, a combination of the references would result in a change in the principle of operation of the references. Moreover, the existence of that difference enables the present invention to avoid rewriting/recoding web pages while still being able to "visually identify, without user intervention, that the telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user."

In response, the Examiner's Answer, at point (C), page 13, paraphrases from MPEP 2145 (III) and states:

In response to applicant's argument that "the applied combination of cited references changes the principle of operation of the references," the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

However, in doing so, the Examiner's Answer completely ignores the warning in the last paragraph of that section which raises the point made in the appeal brief – i.e., that "the claimed combination cannot change the principle of operation of the primary reference." MPEP 2145 (III). (Emphasis added.) It is respectfully submitted that the failure of the Examiner's Answer to address the previous argument about changes in the principle of

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operation is tantamount to an admission that the principle of operation has been impermissibly changed.

Similarly, no office action and no examiner's answer has ever identified why one of ordinary skill in the art following the techniques of the '615 patent would have considered its teachings insufficient such that a modification was necessary. It was Applicant's specification that was impermissibly used as a template for the combination which the rejection picked and chose from the teachings of the references. See e.g., In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and Texas Instruments Inc. v. U.S. Int'l Trade Comm'n, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993). Reversal of the final rejection on that basis alone would be proper.

Also conversely, given that the '615 patent already allegedly had support for providing an indication that a telephone number was known, what was would have been the motivation of one of ordinary skill in the art to use the technique of the '201 patent – especially since the '201 patent's central focus was monitoring “as a basis for targeting advertisements to the user” .. and doing so “without intruding on the user's activities”? See abstract of the '201 patent.

In addition, as argued on page 5 of applicant's Appeal Brief, the claimed structure has the advantage that existing pages need not be redesigned in order to utilize the present invention. Furthermore, parties other than the designer of the web page can provide the information of the present invention if the claimed invention is used, but the cited combination would require access to the web page being displayed – another drawback. The evidence of those advantages was never addressed, let alone rebutted, during prosecution – either during prosecution or in the Examiner's Answer. The failure to address those advantages – advantages not inherent in the cited references – is tantamount to an admission that the present invention is a non-obvious improvement over the cited combination. Reversal of the final rejection on that basis alone would be proper.

Since the above-arguments relate to all the pending claims, it is respectfully submitted that all three groups of claims have been rejected based on an unsupportable combination of references.

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Accordingly, for these reasons and the reasons set forth in Applicant's Appeal Brief, it is respectfully requested that the outstanding final rejection be REVERSED.

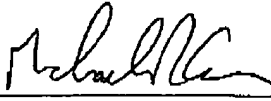
Respectfully submitted,

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